

Remarks

Applicant hereby adds new claims 21-22. Accordingly, claims 1-22 are pending in the present application. Claims 1-5, 7-8, and 10-20 stand rejected under 35 USC 103(a) for obviousness over U.S. Patent No. 5,692,073 to Cass. Claim 6 stands rejected under 35 U.S.C §103(a) over Cass in view of U.S. Patent No. 5,913,542 to Belucci et al. and further in view of U.S. Patent No. 6,203,069 in view of Outwater et al. Claim 9 stands rejected under 35 U.S.C §103(a) in view of over Cass in view of U.S. Patent No. 6,249,716 to Edens et al.

Applicant respectfully traverses the rejections and requests allowance of all pending claims.

Referring to independent claim 1, the Office Action at page 14 identifies teachings of Cass which allegedly disclose or suggest limitations of the recited claim. In particular, at col. 8, lines 30+ it is stated Cass teaches storing a marked document instance. As identified by the Examiner, such teachings refer to storage of the document instance in memory which differs from storage in the separate database of Cass.

More specifically, Cass clearly discloses only storing a received marked document instance in memory. As shown in Fig. 5, Cass discloses extracting an index from the document instance stored in memory which is utilized to extract a reference document stored in the database 520. As clearly shown in Fig. 5, only the index derived from the marked document instance 510 is applied to the database 520 (and not instance 510 itself for storage) to extract an appropriate reference document 521. [There is no storage of marked document instance 510 within database 520] Further, Cass discloses database 520 may be implemented in mass storage 109 or server 40, 50 as distinguished from memory 106 of computer 100.

col 8, lines 20-30 database of 510

[As such, Cass fails to teach or suggest limitations of claim 1 and claim 1 is allowable for at least this reason. For example, claim 1 recites *storing a first communication with an associated identifier code in a database*. Claim 1 further recites *changing the first communication providing a second communication and storing the second communication in the database*. Clearly, Cass is devoid of teaching or suggesting storage of the document instance 510 in database 520.]

Positively recited limitations of claim 1 are not shown nor suggested by the prior art and claim 1 is allowable for at least this reason.

Further with respect to the rejection of claim 1, to establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. See, e.g., MPEP §2143 (8th ed.).

[There is no motivation to modify the teachings of Cass to arrive at Applicant's claim 1 method.] The purpose of Cass is to provide a paper-based user interface (PUI) wherein a user submits commands by marking up paper. As illustrated in Fig. 5, the marked up document instance is used to obtain the corresponding reference document from database 520 which is compared with the marked document instance to identify and interpret the marks in steps 550, 560 and the marks are used to initiate action 570 desired by the user. [There is no motivation to modify Cass to store the marked document instance in a database. Such an interpretation would frustrate the purpose of Cass inasmuch as multiple reference documents would then result and the comparison of the interpretation step 560 would be flawed if the wrong reference document were utilized including marks from a different user desiring different action and rendering the system of Cass incapable of discerning the present user's marks for performing the appropriate respective action from another's mark. There is no motivation to combine the reference teachings and the only motivation improperly results from reliance upon Applicant's disclosure.]

To store the marked document instance 510 in database 520 would destroy the purpose of the invention of the Cass patent. *In re Fitch*, 972 F.2d 1260, 1265 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992) (stating that a proposed modification is inappropriate for an obviousness inquiry when the modification renders the prior art inoperable for its intended purpose). Further, the proposed modification or combination of the prior art would require substantial reconstruction or redesign of the reference teachings and/or would change the principle of operation of the prior art. According to the MPEP, the teachings of the combined

references are not sufficient to render the claims *prima facie* obvious. MPEP 2143.01(8th ed.) *citing In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). Finally, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. MPEP 2143.01 (8th ed.) *citing In re Gordon*, 733 F.2d 900, 221 USPQ 1125 (Fed. Cir. 1984). *In re Fitch*, 972 F.2d 1260, 1265 n.12, 23 USPQ2d 1780, 1783 n.12 (Fed. Cir. 1992) (stating that a proposed modification is inappropriate for an obviousness inquiry when the modification renders the prior art inoperable for its intended purpose). There is no motivation to modify the Cass teachings and the 103 rejection of claim 1 is improper for at least this additional reason. Even if Cass were modified, there is no evidence of record Cass could function as designed and would not inasmuch as the reference document extraction process from database 520 would be inoperable. Claim 1 is allowable for at least the above numerous reasons.

The claims which depend from independent claim 1 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 2 recites *removing a portion of the substrate having a portion of the first communication thereon*. On page 14 of the Action, the Examiner relies upon the teachings of Figs. 10-12 in support of the rejection. The reliance is misplaced.

Initially, Figs. 10-12 and the associated teachings in cols. 13-14 of Cass *are merely illustrative of software processing of the images to identify the marks* and Fig. 12 is not reflective of any communication. In addition, Cass discloses adding marks providing the marked document instance and provides absolutely no removal of a portion of the substrate having the portion of the first communication thereon as recited in claim 2. Further, *the changing of the first communication includes removing a portion of the communication to provide a second communication which is subsequently scanned* as recited in base claim 1. [There is absolutely no teaching or suggestion of scanning of Fig. 12 of Cass.] Numerous limitations of claim 2 are not shown nor suggested by the art and claim 2 is allowable for these additional reasons.

Referring to claim 3, Applicant recites sending a third communication comprising differences between the first and second communications to an output device to display the differences. [Figs. 10-12 are merely illustrative of software processing of the images to identify the marks made by a user and Fig. 12 is not produced, outputted or displayed.] The process of Figs. 10-12 is merely internally performed to identify the marks made by the user to discern the appropriate action to take responsive to the marks as shown in Fig. 5. [Applicant requests specific identification of reference teachings in Cass wherein it is disclosed that Fig. 12 is sent to an output device to display the differences as claimed if claim 3 is not allowed in the next Action.]

Referring to claim 4, there is no merging of a portion of data of the first communication with at least a portion of the digitized second communication to form the digitized third communication or the sending of the third communication to the output device to display the third communication. Claim 4 is allowable.

On page 14 of the Action, teachings of Cass are identified which allegedly disclose limitations of independent claim 7. In particular, it is stated that the stored collection of documents of the database 520 is analogous to having "multiple versions" since each marked document is a different "version" of the original. Applicant disagrees with the interpretation of the Cass teachings set forth in the Office Action and the rejection of claim 7.

Referring to col. 8, lines 12-35, Cass makes clear the marked document instance is stored in memory 109 for indexing *the corresponding original or reference version* of the document in the database 520. The marked document instance is only stored in memory for processing and is not ever stored in the reference document database 520. Database 520 only comprises separate individual original documents and not multiple versions as claimed. Steps 410 and 420 of Fig. 4 discuss obtaining an index from the marked document instance and using the index to extract the appropriate respective original or reference document 521 from database 520. There are no multiple versions of a document stored within the database of Cass as claimed, rather the database 520 of Cass is merely a collection of original, reference documents to be individually compared with received marked document instances which are only provided in memory. The database 520 of Cass only stores original (also referred to as reference documents)

documents and does not store different versions as claimed. The analogy set forth on page 14 of the Action is misplaced and contrary to the explicit teachings of Cass. Claim 7 further recites *a hard copy of one of the versions of a document having a version specific code thereon*. Cass fails to disclose or suggest any teachings with respect to version specific codes as claimed. Numerous limitations of claim 7 are not disclosed nor suggested by Cass and claim 7 is allowable for at least this reason.

The claims which depend from independent claim 7 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

For example, claim 10 recites *sending a prompt to a user when the processor detects that multiple versions of the document are stored in the database and providing input from the user to indicate which of the versions of the document is to have at least a portion extracted from the database*. Cass discloses generating an index from a marked document instance to identify an appropriate original document stored in database 520. There is no prompting or indication of which of multiple versions of the document is to have at least a portion extracted from the database. Cass uses the index to identify the corresponding respective individual original document of database 520 to identify the requested user action 570 of Fig. 5. Limitations of claim 10 are not shown nor suggested by the art and claim 10 is allowable.

Claim 11 recites the documents comprise *multiple sub-components which can be independently updated*. Claim 11 further recites the *multiple sub-components have different component-identifying codes stored on the database to identify the sub-components and the versions of the sub-components*. Claim 11 further recites the hard copy has some component-identifying codes provided thereon which identify the sub-components displayed on the hard copy and the versions of such displayed sub-components. The active elements of Cass fail to disclose or suggest the claimed multiple sub-components and the single document bar code or glyph codes of Cass fail to disclose or suggest the codes on the hard copy identifying the claimed sub-components and versions thereof which may

independently updated. Numerous limitations of claim 11 are not shown nor suggested by Cass and claim 11 is allowable.

Claim 13 recites numerous limitations which are not shown nor suggested by Cass. For example, Cass fails to disclose or suggest *storing multiple versions of a communication in a database*. Cass fails to disclose or suggest saving a *second version* of a communication and a *second identifier code in the database* associated with the second version of the communication. Cass fails to disclose or suggest *recognition of multiple versions of the communication were saved to a database, prompting a user to select which of the multiple versions is to be displayed, or sending at least a portion of a selected one of the data sets to an output device for display*. Numerous limitations of claim 13 are not shown nor suggested by the art and claim 13 is allowable.

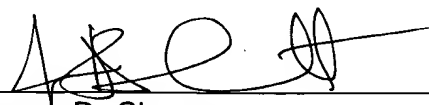
The claims which depend from independent claim 13 are in condition for allowance for the reasons discussed above with respect to the independent claim as well as for their own respective features which are neither shown nor suggested by the cited art.

Support for the new claims may be found at least at Figs. 2-4 and the associated specification teachings at least on page 11.

Applicant requests allowance of all pending claims.

The Examiner is requested to phone the undersigned if the Examiner believes such would facilitate prosecution of the present application. The undersigned is available for telephone consultation at any time during normal business hours (Pacific Time Zone).

Respectfully submitted,
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